Remarks

Amendments to the Specification and Claims

The specification is amended in a further attempt to reformat text that purportedly forms hyperlinks when entered into electronic form at the Patent Office. No new matter is added.

Claim 1 is amended to render the claim more precise by reciting that the promoter "consists of a portion of the nucleotide sequence presented as SEQ ID NO:42". Similar claim language was recently allowed in Applicants' co-pending application no. 09/527,972 (Examiner Ibrahim, Art Unit 1638).

Dependent claims 5, 7-10, 13, 15, and 19 are amended to use the terminology in amended claim 1, resulting in proper antecedent basis.

Claim 9 is further amended to clarify what is intended by the term "control sequence". This amendment is supported by the passage on page 7, lines 6-13, of the specification.

Claim 19 is further amended to correct claim dependency.

No new matter is added. It is believed that the amendments render the claims allowable or, alternatively, place the claims in better form for consideration on appeal. Accordingly, entry of the amendments after final rejection is proper (37 CFR §1.116(b)).

Objection to the Specification

The Examiner objected to the specification because "it contains an embedded hyperlink and/or other form of browser-executable code" (paragraph 4 of office action), and referenced MPEP §608.01. MPEP §608.01 explains that the use of the symbols "<>" and "http://" followed by a URL address will create a live web link when the patent is published on the USPTO web page. These symbols were removed by Applicants' previous amendment. Applicants speculate that perhaps the problem remains because of the use of "www." and have made further amendments accordingly. If the amended text remains problematic Applicants will appreciate the Examiner's suggestions for an appropriate amendment.

Claim Rejections – 35 U.S.C. § 112

In paragraph 5 of the office action, claims 1, 7-19, and 20 were rejected under 35 U.S.C. 112, second paragraph as being indefinite.

Amended claim 1 no longer recites the text that the Examiner considers indefinite.

Claim 9 was rejected because the Examiner finds indefinite the recitation that the heterologous nucleic acid is "operably linked to control sequences" because the claim depends on claim 8, which states that the heterologous nucleic acid is "operably linked to the MEL7 promoter." Claim 9 covers the embodiment wherein the expression vector contains a control sequence in addition to the promoter, for example, an enhancer sequence (see specification p. 7, lines 6-13). It is believed that amended claim 9 recites this more clearly.

The amendment to claim 15 remedies the improper antecedent basis noted by the Examiner.

Amended claim 19 no longer depends from a canceled claim.

For the above reasons, it is believed that all of the rejections raised in paragraph 5 of the office action are overcome.

In paragraph 6 of the office action, claims 1, 5, 7-15, 19 and 20 were rejected under 35 U.S.C. 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey inventors' possession at the time of filing.

Amended claim 1 recites that the promoter "consists of a portion of the nucleotide sequence presented as SEQ ID NO:42." Thus, the Examiner's rationale for rejection that concern the recitation of SEQ ID NO:46, are overcome. With regards to the Examiner's assertion that the "specification correlates the function of fruit-associated promoter activity with SEQ ID NO:42, but not to any fragment thereof", Applicants respectfully disagree. It is evident from Fig. 3A-3C, that SEQ ID NO:42 contains non-promoter sequence in addition to the MEL7 promoter sequence. Further, the specification defines "promoter" as referring "to a sequence of DNA that functions in a promoter disclosed herein to direct transcription of a downstream gene." (p. 7, lines 6-7 of specification). Thus, sequences of DNA within the disclosed MEL7 promoter sequence that can direct transcription of a downstream gene are contemplated by the specification. Accordingly, the subject matter of

claim 1 is described in the specification in a way to reasonably convey possession at the time of filing.

The Examiner remarked at the bottom of page 4 of the office action that the specification "does not literally describe nucleotides 156-1708, of the 1735 nucleotide sequence of SEQ ID NO:42, as having promoter activity." Applicants presume that this remark is directed to a rejection of claim 5 and respond accordingly. MPEP §2163 II (3)(a) states: "If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met." With respect to claim 5, it is readily apparent that nucleotides 156-1708 of SEQ ID NO:42 correspond to the portion of the sequence shown in Fig. 3A-3C as being the "MEL 7 promoter". One skilled in the art would recognize that, at the time the application was filed, Applicants possessed the subject matter recited in claim 5.

For the above reasons, it is believed that all of the rejections raised in paragraph 6 of the office action are overcome.

In paragraph 7 of the office action, claims 1, 5, 7-15, 19 and 20 were rejected under 35 U.S.C. 112, first paragraph on the basis that the specification "does not reasonably provide enablement for... any other sequence from within 1560 nucleotides upstream of SEQ ID NO:46...". Amended claim 1 recites that the promoter "consists of a portion of the nucleotide sequence presented as SEQ ID NO:42." Thus, the Examiner's rationale for rejection that concern the recitation of SEQ ID NO:46, are overcome.

In the middle of page 6 of the office action, the Examiner stated: "the specification does not mention that bases 156-1708 in particular have any promoter activity". Applicants respectfully disagree. As discussed above, Fig. 3A-3C designate a "MEL7 promoter" region that corresponds to bases 156-1708 of SEQ ID NO:42. The Examiner argued further "...nor does the specification teach any other fragment of SEQ ID NO:42 that retains its activity." While specific sub-fragments of the MEL7 promoter region that retain fruit-associated promoter activity are not described in the specification, contrary to the Examiner's assertion, one skilled in the art is not "left to make all possible fragments of all possible sizes." Rather, routine promoter deletion analysis can be used to identify

sequences of DNA within the disclosed MEL7 promoter sequence that can direct fruit-associated expression of a downstream gene. This does not constitute undue experimentation.

For the above reasons, it is believed that all of the rejections raised in paragraph 7 of the office action are overcome.

In view of the claim amendments and for the above reasons, it is believed that all of the rejections are overcome, and that the claims are in condition for allowance. The Examiner is encouraged to telephone the undersigned to discuss any further issues that may need resolution prior to allowance.

Respectfully submitted,

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